

REMARKS/ARGUMENTS

STATUS OF CLAIMS

In response to the Office Action dated September 5, 2008, claims 1-8, 49, 50 and 63-66 have been amended. Claims 1-92 are now pending in this application. No new matter has been added.

REJECTION OF CLAIMS UNDER 35 U.S.C. § 103

Claims 1-92 have been rejected under 35 U.S.C. § 103(a) as being unpatentable over Yamamoto et al. (USPN 7,228,339) in view of Iwamura (USPN 6,807,28), for the reasons substantially of record.

The remarks advanced in the previous Response in support of traversing the imposed rejection of claims 1-92 under 35 U.S.C. § 103 for obviousness predicated upon Yamamoto et al. in view of Iwamura are incorporated herein by reference thereto.

The Examiner alleges “it will be obvious to one ordinary skilled in the art at the time the invention was made to modify Yamamoto’s restriction section to include Iwamura’s specific image portion that extracts or discriminates between the confidential and non-confidential image” (see page 12, line 17 to page 13, line 3 of the Office Action).

As described in the present application, the image forming apparatus 10 of the present invention conducts output processing such as, for example, printout (copying and printing) (see page 33, lines 23-24 of the present application). “When the authentication is not completed, ... color restriction section 110 then *deletes the specific color portion*” (see page 40, lines 2-5 of the

present application). “As a result, ... the non-specific color portion 701 is recorded (outputted) on the recording paper 710, whereas *the specific color portion 702 is not recorded*” (see page 41, lines 4-6 of the present application). “When the authentication is completed, ... both the specific color portion 702 and the non-specific color portion 701 *are recorded* on the recording paper 720” (see page 41, lines 7-11 of the present application).

To expedite prosecution, independent claims 1-8, 49, 50 and 63-66 have been amended to clarify the difference between the present invention and the combination of Iwamura and Yamamoto et al. Thus, independent claim 1 now recites “deleting the extracted specific color portion from the received color image data, wherein the specific color portion is output to be visible for the requestor, when the authentication is completed”. Independent claims 2-8, 49, 50 and 63-66 have been amended to recite similar subject matter.

The inventions now recited in amended independent claims 1-8, 49, 50 and 63-66 bring about the following merits, which are described at page 44, line 19 to page 45, line 1 of the present application:

Since the copying or the printing of a confidential portion prepared in a specific color is restricted the security is improved. The copying or the printing of the specific color portion can be performed on the basis of the authentication or instruction. This improves the user convenience, with maintaining a high security level. Further, since the confidentiality is ensured by preparing the confidential portion in the specific color, a document containing a confidential portion can be prepared easily and efficiently.

With respect to the above-noted allegation of the Examiner, “Iwamura’s specific image portion” seems to be the “digital watermark” for copyright protecting technique (see column 1, lines 7-60 of Iwamura).

Iwamura describes what the “digital watermark” is at column 1, lines 33-48:

If the copyright holder or sales agent (hereinafter both are collectively called a server which can legally distribute commodities of digital data) once sends a commodity to a buyer, the copyright of the commodity may be infringed because it is impossible *to completely prevent illegal copies of the commodity and alteration of the contents of the commodity*. (Emphasis Added)

As techniques of solving such problems associated with electronic commerce, techniques called “*digital watermark*” has been studied. (Emphasis Added)

Digital watermark techniques embed copyright information of digital data and user information of a buyer *in the digital data itself* by processing original digital data and making it *invisible*. By incorporating the digital watermark techniques, if an illegal copy is found, it is possible to identify the person who redistributed the illegal copy. (Emphasis Added)

The above means, the “digital watermark” *should be kept in the digital data all the time*, even if it is invisible for users in an output of the digital data, because the “digital watermark” is used *to completely prevent illegal copies of the commodity and alteration of the contents of the commodity*. In short, *the “digital watermark” is NOT “deleted”* from the digital data.

Thus, Iwamura does **NOT** disclose the feature “deleting the extracted specific color portion from the received color image data” now recited in the currently amended independent claims. Furthermore, as described in Iwamura, “*Digital watermark techniques embedded copyright information ... by ... making it invisible*” (see column 1, lines 43-46 of Iwamura). This means, the “*digital watermark*” *is invisible for users* in the output of the digital data *all the time*, even if the digital data performs an output process such as printing or facsimile.

Thus, Iwamura does **NOT** disclose the feature “wherein the specific color portion is output to be *visible for the requestor*, when the authentication is completed”, now recited in

amended independent claim 1. Similar subject matter is recited in amended independent claims 2-8, 49, 50 and 63-66.

As a result, the inventions now recited in amended independent claims 1-8, 49, 50, and 63-66 would **NOT** result if a person of ordinary skill in the art at the time the invention was made were to modify Yamamoto's restriction section to include Iwamura's specific image portion, as suggested by the Examiner. In addition, above-described merits of the present invention do not result when Yamamoto's restriction section is modified to include Iwamura's specific image portion.

Claims 9-48, 51-62 and 63-92 depend directly or indirectly from respective ones of amended independent claims 5-8, 4, 50 and 63-66. Therefore, claims 1-92, as amended, are patentable over Yamamoto et al. and Iwamura.

II. In view of the above, the allowance of claims 1-92, as amended, is respectfully solicited.

CONCLUSION

In view of the above, applicant(s) believes the pending application is in condition for allowance.

Should there be any outstanding matters that need to be resolved in the present application, the Examiner is respectfully requested to contact Edward J. Wise (Reg. No. 34,523) at the telephone number of the undersigned below, to conduct an interview in an effort to expedite prosecution in connection with the present application.

If necessary, the Commissioner is hereby authorized in this, concurrent, and future replies to charge payment or credit any overpayment to Deposit Account No. 02-2448 for any additional fees required under 37.C.F.R. §§1.16 or 1.14; particularly, extension of time fees.

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Respectfully submitted,

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